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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/802,472	02/18/1997	CHARLES KORMANIK JR.		7544

7590 12/02/2003
PETER K TRZYNA
P O BOX 7131
CHICAGO, IL 606807131

EXAMINER

LUBY, MATTHEW D

ART UNIT	PAPER NUMBER
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3611

DATE MAILED: 12/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/802,472

Applicant(s)

KORMANIK, CHARLES

Examiner

Matt Luby

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5,9-15,17-31 and 49-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 24-26 is/are allowed.
- 6) ☒ Claim(s) 5,9-15,17,18,20,22,23,28-31,49,51,53,55 and 57 is/are rejected.
- 7) ☒ Claim(s) 19,21,27,50,52,54,56 and 58 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 February 1997 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

Renumbered Claims

1. Newly submitted claims 32-41 have been renumbered 49-58 in accordance with Rule 1.126.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed limitations of claims 9-15 and 58 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.
3. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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6. The limitation "wherein the step of constructing the package to have additional utility" (claim 21, line 2) has no antecedent basis.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 5, 9, 11, 13, 20, 22, 28, 30 and 31, are rejected under 35 U.S.C. 102(b) as being anticipated by Gossard (U.S. Patent 3,624,939).

9. Gossard discloses a method for making a package that is shaped like any kind of imaginable symbol (here the package is made to be shaped like a baseball, football or soccer ball - Figures 1-6 and 11), wherein the package contains an article shaped differently from the package itself (photographs 16, of athletes) and the outside shape of the package can be interpreted to represent any kind of imaginable activity associated with the shape of the package and the article contained therein, wherein the activity is a sport activity (here, this is interpreted to be the activity of collecting sports memorabilia including signatures on photographs of athletes which includes the subset of sporting events including the games of baseball, football and soccer), wherein the package has a hollow interior whereby the method is completed by locating one article and another article in the hollow interior (Figures 1-6 and 11 show multiple photographs located in the hollow of the package), where the package has additional utility

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independent from containing the article such as a toy (a ball to be played with or a paperweight, Figures 1-6 and 11) wherein the package is constructed of a substance capable of receiving subsequent writing from a pen or magic marker (Figures 1-6 and 12 show packages which are constructed from a substance "capable" of receiving writing from a pen or magic marker), wherein the package has separably joinable pieces, the pieces being joinable to form the hollow interior of the package and being separable to open the package for the removal of the article (Figure 2) and the combination(s) is/are marketed (e.g., sold - all products are sold, this is the very essence of business).

10. Regarding the limitation "constructing the package out of a substance capable of receiving subsequent writing from a pen or magic marker" (claim 22), it has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 8, 10, 12, 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gossard.

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13. While Gossard discloses making a package shaped like a baseball, football or soccer ball, there is no specific disclosure to making the package in the shape of a golf ball, a life preserver, a tennis ball, a wheel or a charge/bank card and where the activities are the game of golf, a race, the game of tennis, a race, and using a card, respectively (in accordance with claims 8, 10, 12, 14 and 15). It would have been an obvious matter of design choice to make the package in the shape of whatever desirable or creative packaging the manufacturer intends to market to the target audience since shapes of packages are considered a mere matter of the marketing process (this is clearly evident from the multiple marketing target shapes present in the Gossard patent) and since applicant has failed to disclose that the limitation solves any stated problem or has any criticality, whatsoever. *In re Kuhle*, 188 USPQ 7, CCPA 1975. Furthermore, it would have been an obvious matter of design choice to make the package of whatever form or shape was desired or expedient. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47. Still further, Gossard specifically mentions at lines 20-25 that the container shapes depicted are merely exemplary of the most common sports and therefore it is well within the scope of Gossard to have the container be shaped to represent any sport/activity associated with the photograph contained therein (wherein the activity and association are entirely subjectively determined, in this case by the Examiner, consistent with the 112, 2nd paragraph rejection above).

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14. Claims 17 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gossard in view of Francis (U.S. Design Patent 346,185).

15. Gossard discloses all of the claimed invention except for locating a logo on the package and imprinting a message on the package the message being suggestive of the use of the article. Francis discloses that it is notoriously well known in the art of packages to place a logo thereon/imprint a message on the package which is suggestive of the use of the article (see Figure 1) in order to represent what the package contains (this is possibly the oldest, inherent characteristic of packages - e.g., wording that describes what is inside the package). It would have been obvious to one of ordinary skill in the art at the time of the invention to locate a logo/imprint a message on the Gossard package which is suggestive of the use of the article, as taught by Francis in order to represent what the package contains.

16. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gossard.

17. Gossard discloses all of Applicant's claimed invention but does not specifically disclose adding an outer layer of packaging shaped to visually suggest information about the associated activity. It would have been an obvious matter of design choice to add an outer layer of packaging shaped to visually suggest information about the associated activity since this is an inherently old and well known concept in the art of packaging/marketing (i.e., adding a plastic bubble enclosing the contents for sale in a store as well as for shipping purposes, to protect the contents, and also printing the contents or various characteristics of the contents on the outside layer of packaging,

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which in the instant case may include: "Baseball shaped sports memorabilia Bank" or a similar phrase, along with the location of the manufacturer). *In re Kuhle*, 188 USPQ 7, CCPA 1975.

18. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gossard in view of Schaffer (US Design Patent 196,679).

19. Gossard discloses all of Applicant's claimed invention except for securing to an exterior part of the package a means for attaching the replica to another article. Schaffer discloses securing to an exterior part of a package a means for attaching the replica to another article (the carrying chain, shown in Figures 1-3) in order to provide a convenient carrying mechanism (the inherent value in a carrying chain, which may be attached to a key ring, for example). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide securing to an exterior part of the package a means for attaching the replica to another article on the Gossard method as taught by Schaffer in order to provide a convenient carrying mechanism.

20. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gossard.

21. Gossard discloses the claimed invention except for specifically disclosing that the replica and article are made of plastic. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the replica and article of plastic since this is a readily available, inexpensive material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re*

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Leshin, 125 USPQ 416. See also *Ballas Liquidating Co. v. Allied industries of Kansas, Inc.* (DC Kans) 205 USPQ 331.

22. Claims 51, 53, 55 and 57 as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Gossard.

23. Gossard discloses all of Applicant's claimed invention (as has been explained in the 102 rejection above) except that the method includes making more than one combination package and article. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make multiple combinations of a package and article, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art, and for efficiency in production. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Allowable Subject Matter

24. Claims 19, 21 and 52 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art fails to disclose a method of making a combination of a thematic package and an article contained therein which includes an outer layer that has a sleeve for golf balls.

25. Claims 24-26 are allowed.

26. Claims 27, 50, 54 and 56 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the

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limitations of the base claim and any intervening claims.. The prior art fails to disclose the step of locating carried out with rain gear as the article.

27. Claim 58 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art fails to disclose the step of locating carried out with the article from a group consisting of sun screen, a band-aide, a golf tee, a ball mark, insect repellent and bee sting treatment.

Response to Arguments

28. Applicant's arguments filed 9/15/03 have been fully considered but they are not persuasive.

29. The 112, 2nd paragraph rejections are hereby withdrawn due to the amendments made in Paper 39, which have overcome these rejections. Additionally, it is noted that the claim language in claims 5 and 51 is very, very broad and the under the broadest reasonable interpretation the Examiner is interpreting claims 5 and 51 to mean: a method for making a package/packages (which is a replica, meaning just a copy) that is/are shaped like any kind of imaginable symbol, wherein the package contains an article shaped differently from the package itself and the outside shape of the package can be interpreted to represent any kind of imaginable activity associated with the shape of the package and the article contained therein, wherein the package has a hollow interior whereby the method is completed by locating the article in the hollow interior.

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30. In response to Applicant's assertion on page 12 of the response that "the PTO has applied the objective standard of what is suggestive to symbols in examining applications for trademark registration for decades", this is not a trademark application. This is a **PATENT** application. Applicant's representative, Peter Tryzna, has already been informed that this is not a trademark application in the interview held 9/15/03 (Paper 37). To further clarify this issue for Applicant's representative, Peter Tryzna, who apparently believes that Patent Examiners are obligated to follow the Trademark Manual of Examining and particularly TMEP 1209.01(a) titled "Fanciful, Arbitrary, and Suggestive Marks", Patent Examiners are not bound by the TMEP. Furthermore, this section applies to "Marks" of which a patent application has none. There are two separate Commissioners in the United States Patent & Trademark Office. One Commissioner heads the Patent Office and one Commissioner heads the Trademark Office. Patent Examiners follow the MPEP not the TMEP. Finally, patent applications and trademark applications are two distinct legal documents which are governed by separate laws. Therefore, if Applicant brings up arguments regarding the TMEP for the remainder of the prosecution, these arguments will, on their face, be moot, and hence, will be ignored.

31. In response to Applicant's assertion on page 13 that there is no prior art evidence that the football of Gossard conveys information or suggests collecting memorabilia including going to a sporting event, the evidence is the Figures of Gossard which are suggestive of sporting activities and collecting sports memorabilia.

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In response to Applicant's arguments (page 15) that Gossard does not mention plastic, additional utility, a material or substance which can receive writing from a pen or magic marker, or constructing as a toy, these limitations which are all in claims that have been amended, are met by the prior art, as discussed above. The limitations drawn to the additional utility, constructing as a toy and the capability of receiving writing from a pen or magic marker are rejected under Gossard and the limitation regarding plastic is rejected under design choice as being a very old and well known material in the art to which Gossard pertains.

32. In response to Applicant's assertions that the 103 rejections of claims 8, 10, 12, 14 and 15 are invalid on pages 15-16 because these claims solve a stated problem, no disclosure is present as to how the specific shapes solve a stated problem over the specific shapes which were already rejected in the main reference, Gossard, under 35 U.S.C. 102. The 103 rejection merely applies well established case law that a mere change in shape is well known. The Applicant goes on to state that the Board rejected this reasoning (that a change in shape is a matter of design choice). The Board did not reject the reasoning applied above. It rejected a 103 rejection over Agapiou and remanded to the Examiner because it obviously knew that the claims of record are not patentable, especially merely changing the shape of the package from one type of sports ball to another or to a life preserver or credit card. Is it Applicant's contention that these shapes are patentably distinct? If so, it is requested that Applicant go on the record and state that the changing of the shape of the package from a baseball, football or soccer ball to a golf ball, life preserver or credit card shape is patentably distinct.

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Applicant is also reminded that the Board did remand and did not reverse if they wish to pursue the same flawed argument on Appeal again.

33. Regarding Applicant's argument on page 18 that a reference is required, evidence has been presented in connection with the rejection of claim 18 that the limitations at issue are inherent properties of packages. Examiner has personal knowledge and knows of no one that would contradict the statement that is inherent to put an outer layer of packaging (such as a plastic bubble) on a package (such as that shown in Gossard) for display in a store to visually convey information about the associated activity (i.e., to let the package inside the outer layer speak for itself). If Applicant's may wish to rebut this they but that contention would be absolutely ludicrous. One may walk into any department store in the country and see that this rejection is easily met by merely browsing the aisles.

Conclusion

34. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matt Luby whose telephone number is (703) 305-0441. The examiner can normally be reached on Monday-Friday, 9:30 a.m. to 6:00 p.m..

35. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (703) 308-0629. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9326.


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36. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Matt Luby
Examiner
Art Unit 3611



M.I.
November 25, 2003



LESLEY D. MORRIS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600